

REMARKS

Summary

Claims 1-26 were pending, and all of the Claims were rejected in the Office action. The Applicants respectfully traverse the rejection of the claims, as set forth below.

DETAILED RESPONSE

A) Written consent of all assignees

The Applicants note that in one of the two places in the assent of the assignee where the inventors were mentioned, the inventors were listed in error. Accompanying this paper is a supplemental Consent which rectifies the error.

B) Priority

The Reissue Declaration, in paragraph 1 thereof, incorporated the declarations made in the original application. As such the Reissue Declaration encompassed the priority claim previously made in the declaration for the original patent, although not explicitly. However, in order to obviate the Examiner's assertion that foreign priority has not been properly claimed, the Applicants have prepared an Application Data Sheet, explicitly incorporating the reference to the foreign application and the priority claim. The Application Data Sheet is appended hereto.

C) Declaration.

The Examiner deems the declaration filed in this application defective because "the error which is relied upon to support the reissue application is not an error upon which a reissue can be based." (Office action, page 3). The Applicants respectfully traverse this determination.

The Examiner relies on 37 CRF 1.175(a)(1) and MPEP §1414, and in particular MPEP §1412: Failure to Timely File a Divisional Application Prior to Issuance of Original Patent.

The Applicants respectfully submit that the portion of the MPEP cited by the examiner is not applicable to this case, and to the extent that it may have been thought to be applicable by the USPTO, the holding in *In re Doyle* (63 USPQ2d 1161 (CA FC 2002)) particularly obviates the applicability of this criterion to the present circumstances in a reissue application.

In the Reissue Declaration, the Applicants stated that:

One error that is being corrected in the Preliminary Amendment is that we consider one aspect of the disclosed invention to cover plasma treatment equipment that comprises a chamber wall and a susceptor electrode having at least one of an electrode and an electrode shield, at least one of the electrode and the electrode shield being at the same DC potential as the chamber wall, wherein at least one of the at least one of the electrode and the electrode shield being at the same DC potential as the chamber wall is AC shorted to the chamber wall. Claim 1 of the original '670 patent, however, only recites a plasma treatment equipment in which a chamber wall and a susceptor electrode having the same DC potential are AC shorted to each other. At least this error is being corrected by adding new claims in the Preliminary Amendment.

The headnotes to the decision in *In re Doyle* summarize the holding as:

Applicant is entitled to reissue of patent in order to broaden claims after failing to present, during prosecution of original application, claims broad enough to read on or "link" two or more groups of claims subject to examiner's restriction requirement, since proposed reissue claims are genus claims that read on nonelected species claims, and thus are substantially broader than claims of nonelected groups, since applicant neither asserted reissue claims in original application nor agreed to prosecute such claims in divisional application, and since applicant could have prosecuted these linking claims with claims of elected group without conflict with restriction requirement; applicant thus has successfully asserted error in issued patent correctable by reissue, and is not subject to rule that precludes reissue applicant from obtaining claims substantially identical to those of nonelected groups identified in restriction requirement if such claims could not have been prosecuted in application from which they were restricted.

The court particularly distinguished the present situation from the line of cases associated with *In re Orita*, 550 F.2d at 1281, 193 USPQ at 149. That is, the court determined that applicability of the *Orita* precedent is more limited than asserted by the USPTO in the MPEP. Consequently, the MPEP does not provide appropriate guidance for the present circumstances, and the decision in *In re Doyle* should be relied upon in the present reissue application. As such, the Applicants respectfully submit that the declaration provides all of the necessary declarations and assertions such that the claims in the reissue application should be considered on their merits. In particular, at least one of the new claims provides a recitation of subject matter that is identified in the declaration and which satisfies the conditions set forth in *In re Doyle*. The Applicants respectfully submit that the rejection of Claims 1-23 on the basis of a defective declaration should be withdrawn.

D) Specification

The Examiner has objected to the disclosure on the basis that the "copy of the specification filed by applicants is improper in that it does not incorporate the changes made by the certificate of correction, see MPEP 1411.01 (note that the change made by certificate of correction cannot be done through a preliminary amendment)" The MPEP, at § 1411 (B) specifically permits a preliminary amendment directing that the specified changes be made to the copy of the printed patent.

The Examiner has required a substitute specification; however MPEP §1411.01 suggests that a substitute specification should be required when the changes are extensive. In this instance, the only change made by the certificate of correction is to correct a claim reference in one claim.

The Applicants accept that the change Claim 5 is made only to incorporate the Certificate of Correction and is not by way of an amendment made in the reissue application. Considering that the certificate of correction changes the patent as issued as if the patent had been reprinted with the correction incorporated, it would appear that an appropriate means of making the correction is to consider the issued claim to be part of the printed patent specification. The present response includes an amendment to the specification to effect the incorporation of the subject matter of the Certificate of

Correction. To prohibit such an action as a formality, and to require a substitute specification to effect the change, places an undue burden on the Applicants to rectify an error made by the USPTO in printing the patent.

E) Preliminary Amendment

The preliminary amendment would appear to have been entered and considered by the Examiner, and thus is not resubmitted. To the extent that the statement of Claim 5 in the preliminary amendment is considered improper, this objection has been obviated by the specification amendment in this response.

Claim Rejections

Claims 1-23 were rejected as being based on a defective reissue declaration under 35 U.S.C. 251 and 37 CFR 1.175. The Applicants respectfully submit that the declaration itself is not defective with respect to 37 CFR 1.175 in that it provides the recitations set forth in paragraph (a) thereof.

The Applicants respectfully submit that the rejection should be withdrawn and that the claims ought to be considered on their merits. As the claims have not as yet been considered on their merits the Applicants respectfully submit that the next Office action should be non-final.

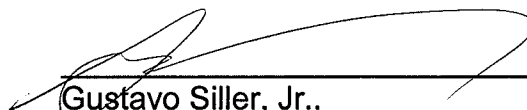
Conclusion

Claims 1-23 are pending. A marked-up copy of the changes to the specification is provided in Annex A.

The Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,


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Annex A

Marked-up Copy of Changes

In the Specification:

Please replace claim 5 in the printed copy of the patent with the following:

5. (Amended) The plasma treatment equipment according to claim [3]4, wherein the said metal plate is inclined with respect to the bottom wall, and an angle formed between said metal plate and the bottom wall is less than 45 degrees.